

Remarks

Claims 1-21 are currently pending in the patent application. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated December 21, 2007 indicated that: claim 14 stands rejected under 35 U.S.C. 101; claims 1-7, 12-13, and 15-19 stand rejected under 35 U.S.C. 103(a) over Garg *et al.* (U.S. Patent No. 5,493,687) in view of Boice *et al.* (U.S. Patent No. 6,301,671); and claims 8-10, 20 and 21 stand rejected under 35 U.S.C. 103(a) over Garg in view of Boice, and further in view of Gupta *et al.* (U.S. Patent No. 5,996,083). Applicant maintains and incorporates the traversals of these rejections as presented in the previous Office Action, which are repeated in the instant Final Office Action.

As the rejection of claim 11 has been removed, Applicant understands that claim 11 should be in condition for allowance.

The Section 101 rejection of claim 14 must be reversed because the Final Office Action's assertion that "wireless transmission media and other types of propagated signals" are nonstatutory subject matter is contrary to Section 101 and the very portions of the M.P.E.P. that are relied upon in making the rejection. Specifically, M.P.E.P. §2106 indicates that functional descriptive material that is "recorded on some computer-readable medium" can be statutory. This is consistent with the Examiner's indication at page 3 of the Final Office Action, indicating that claim 14's "recitation of a storage device" would be statutory. M.P.E.P. §2106 goes on to describe computer-readable medium as a medium "in a computer or on an electromagnetic carrier signal." In this context, the claimed signal bearing medium as a "transmission medium" (*e.g.*, an electromagnetic carrier signal) is statutory subject matter. In short, it appears that the Final Office Action misinterprets M.P.E.P. §2106 as requiring that such a statutory medium be a physical medium, where this section clearly states that a computer-readable medium may be an electromagnetic carrier signal. This is consistent with the USPTO's database, which includes over 250 issued patents having claims directed to a "signal-bearing medium" as discussed in the previous response of record. In this regard, claim 14 is directed to statutory subject matter and the Section 101 rejection must be reversed.

As claim 14 does not stand rejected over any prior art or otherwise, Applicant understands that claim 14 should also be in condition for allowance.

Applicant respectfully traverses the Section 103(a) rejection of claims 1-7, 12, 13, and 15-19 because the cited portions of the Boice reference do not correspond to claimed limitations directed to selectively disabling an unused register bank by gating off each of clock, address and data inputs of the register bank as suggested in the Final Office Action. The Final Office Action cites to two different portions of the Boice reference (*e.g.*, the first relating to FIG. 7(a/b) and the second to FIG. 8), each directed to different embodiments, which achieve power savings by respectively selectively clocking an on-chip array and by selectively updating a register. Neither of these cited embodiments, alone or in combination, provide correspondence to the claimed limitations directed to gating off clock, address and data inputs (*e.g.*, to turn off unused registers).

Referring to FIG. 7(a) and corresponding description at column 10:17-34 in the Boice reference, a logic signal transitions the clock of an on-chip array 200 “only when needed” to serve its power-saving purpose. Boice does not disclose gating off a clock input of a register bank (or address and data inputs) to disable an unused bank as claimed in the instant invention. Referring to FIG. 8 and corresponding description at column 10:43-67, the embodiment characterized in these sections of the Boice reference does not gate a clock signal to an on-chip array, and instead achieves its power savings purpose by controlling the selective update of registers with control signals 210 and 212. That is, the embodiment shown in and described in connection with FIG. 8 does not teach or suggest disabling address and data inputs to disable a bank; register updates are simply controlled to occur only when the value in the register changes, saving power regardless of the clock input (with a free-running clock signal continually applied). In this regard, the Boice reference’s power savings purpose involves either controlling the transition of a clock or controlling the update of a register, thus failing to provide correspondence to disabling an unused register bank by gating off of all three of clock, address and data inputs. Accordingly, the Section 103(a) rejection of claims 1-7, 12, 13, and 15-19 is improper and Applicant requests that it be withdrawn.

Applicant further traverses the Section 103 rejection of claims 1-7, 12, 13, and 15-19 because the asserted motivation is unsupported by any evidence from the prior art.

Specifically, the Examiner predicts, at pages 4 and 5 of the final office action, that “gating the clock, address and data signals of Garg’s register bank would prevent unnecessary signal transitions in the register bank, thus providing the benefit of reducing power dissipation.” However, the Final Office Action is silent as to any description as to why this prediction would be applicable to the Garg reference, and offers no evidence of motivation for modifying the Garg reference as suggested. Instead, the Final Office Action cites portions of the Boice reference that are directed to “obviating unnecessary internal array node transitions” for power reduction in a video encoder device. The Examiner has not indicated, and the Applicant cannot ascertain, any discussion of issues relating to “unnecessary internal array node transitions” in Garg’s RISC microprocessor or that Garg’s microprocessor is susceptible to any internal array node transitions that would benefit from the proposed combination of references. In this regard, the rejection has failed to provide evidence of motivation and must be reversed.

Applicant respectfully traverses the Section 103(a) rejection of claims 8-10, 20 and 21 because the cited combination of the Garg and Boice references does not correspond to the claimed invention as discussed above in relation to the Section 103(a) rejection of claims 1 and 15. In at least this regard, the rejection of claims 8-10, 20 and 21 is improper in that these claims depend from claim 1 or claim 15 (if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, Applicant requests that the Section 103(a) rejection of claims 8-10, 20 and 21 be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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